

REMARKS

Claims 1-3, 5-12, 14-20, 22-31 and 33-35 remain in the application for consideration. In view of the following remarks, Applicant respectfully requests that the application be allowed and forwarded on to issuance.

5

The Rejections

Claims 1 and 12 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,163,383 to Ota et al (hereinafter "Ota") in view of Evans (20020113995 A1).

10 Claims 2-11 and 13-35 stand rejected under 35 U.S.C. §103(a) as being obvious over Ota in view of Hines (2002/0031225 A1).

Before undertaking a discussion of the substance of the Office's rejections, the following discussion of the §103 Standard is provided.

15 **The § 103 Standard**

To establish a prima facie case of obviousness, *three basic criteria must be met*. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958
 20 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580
 25 (CCPA 1974). The teaching or suggestion to make the claimed combination and

the reasonable expectation of success *must* both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1439 (Fed. Cir. 1991).

Hence, when patentability turns on the question of obviousness, the search
5 for and analysis of the prior art includes evidence relevant to the finding of
whether there is a teaching, motivation, or suggestion to select and combine the
references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin
Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)
("the central question is whether there is reason to combine [the] references," a
10 question of fact drawing on the Graham factors). The mere fact that references *can*
be combined or modified does not render the resultant combination obvious unless
the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d
680, 16 USPQ2d 1430 (Fed. Cir. 1990). "To support the conclusion that the
claimed invention is directed to obvious subject matter, either the references must
15 expressly or impliedly suggest the claimed invention or *the examiner must present
a convincing line of reasoning as to why the artisan would have found the
claimed invention to have been obvious in light of the teachings of the
references.*" *Ex parte Clapp*, 227 USPQ 972, 973 (Bd.Pat. App. & Inter.
1985)(emphasis added).

20 Chapter 2100 of the MPEP provides further instruction as follows: "With
regard to rejections under 35 U.S.C. 103, the examiner must provide evidence
which as a whole shows that the legal determination sought to be proved (i.e., the
reference teachings establish a *prima facie* case of obviousness) is more probable
than not." See MPEP 2142.

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("***Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.***"); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)); *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("***It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. [O]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.***") (quoting *In Re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

The Ota Reference

Ota provides a print processing apparatus in which, when an access control such as print instructions are received from a plurality of protocols and the use of a certain printer is allowed only to a specific user, user authentication is performed in different manners, depending on clients, by using a *user authentication* scheme which is most reliable to the respective users.

Ota discloses a print processing apparatus which processes print instructions in plural protocols. User information is produced and includes an identification which identifies a user as a sole user in an environment of a client. Instructions of operations are issued relating to print processing while transmitting the identification. User authentication is performed and so-called support authentication level storing means stores a security policy as to whether or not it is required to verify correctness of the identification. A so-called correctness inquiry judging judges whether or not correctness of the identification is to be inquired, in accordance with the security policy. When it is judged that correctness is to be inquired, a user verification verifies the correctness of the user in response to inquiry of correctness of the identification. Operation control is provided for restricting operations on a printer to an operation which is allowed to the user verified.

The Evans Reference

Evans discloses a two-phase asynchronous print tracking system. In this two-phase scheme, a print job is sent from a client computer to a server computer, where its existence is detected, and where data about the print job is extracted. The extracted data is sent to a central message queue, where the client computer reads the data and graphically notifies the user of the existence of unbilled print activity. Billed print job information is written to a central location, where a management interface allows for viewing and reporting of print data.

10 A quota, defined by a system administrator, *determines how many unbilled print jobs can exist for a given user before a mandatory billing interface is displayed*. While a given user's unbilled print count is below the quota, the user may recall the billing interface at his or her discretion. The user may thus delay the entry of the required billing information to a convenient time, but cannot avoid
15 entering the information and cannot indefinitely delay entry of the information to a point where the user may no longer recall the pertinent information. Enforcement is accomplished once the quota is reached by obscuring the computer screen with the billing interface.

Evans is based on the view that printing should remain a native process, and
20 takes a "hands off the printing process" approach that makes few if any modifications to the process of printing. *Thus at the core of Evans, as described by Evans, is an intention to impose the fewest restrictions upon users while maintaining a reliable record of print events for cost allocation and recoupment.*

The Office's Attempted Combination Ota and Evans

In attempting to combine Ota and Evans, the Office argues that Ota discloses most of the various recited features except for monitoring one or more variables or parameters associated with I/O activities of data that is to be or has
5 been printed on the printer. The Office then relies on Evans and argues that Evans discloses monitoring I/O activities.

Given these two references, the Office argues that their combination would render the subject matter of many of the claims obvious. In support of its argument, the Office argues that the skilled artisan would have readily recognized
10 the desirability and advantage of modifying Ota by employing the system of Evans to gather information that could be used to charge for services or maintain a record of the print jobs performed.

Applicant respectfully disagrees with the Office's combination and its stated motivation to combine these references. As such, Applicant respectfully
15 submits that the Office has failed to establish a *prima facie* case of obviousness.

Consider, for example, the nature of Ota's disclosure. Specifically, as discussed above, Ota teaches a user authentication system that determines whether the current user is allowed to use a certain printer. The Office argues that it would be obvious to employ Evan's system in Ota's system so that information could be
20 gathered and used to charge for services or maintain a record of the print jobs performed.

Applicant respectfully submits that Ota does not contemplate or in any way suggest a system that charges users for using a printer. Furthermore, Ota's system and method have no need whatsoever for charging for services or maintaining a
25 record of print jobs performed. Ota is only concerned with making sure that a user

has access to a printer before allowing the user to use the printer. In fact, Ota seems to be best implemented in the context of a business environment, where certain employees are restricted from printing certain information due to security concerns. In the context of a business environment, it is unlikely that a business
5 would charge its own employees to use its printers.

Based on the reasons set forth above it appears as though the Office has used hindsight reconstruction in arguing that Ota could be modified by Evans so that information could be gathered to charge for services or maintain a record of print jobs performed. As discussed above, *"[i]t is impermissible to use the claimed
10 invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. [O]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."* In this case, there is no mention whatsoever in Ota of a desire to charge users for printing or to maintain a record of
15 print jobs. Thus, in arguing that Ota could be modified by Evans, the Office has clearly used the claimed subject matter as an instruction manual, and attempted to piece together the teachings of the prior art so that the claimed subject matter is rendered obvious. As discussed above, this is hindsight reconstruction, which is not allowed as a basis for making out a §103 rejection.

20 Accordingly, for at least these reasons, the Office has failed to establish a *prima facie* case of obviousness.

The Claims

Claim 1 recites a printing apparatus comprising [emphasis added]:

25

- a printer configured to print upon print media; and
- a printer monitor associated with the printer and configured to monitor one or more variables or parameters associated with the security of the printer, *wherein at least one of said variables or parameters is associated with I/O activities of data that is to be or has been printed on the printer.*

As discussed above, the Office's stated motivation for combining Ota and Evans in this rejection does not rise to the level of a motivation that supports a *prima facie* case of obviousness.

In view of the above discussion, the Office has not established a *prima facie* case of obviousness. Hence, for at least these reasons, this claim is allowable.

Claims 2, 3 and 5-11 are allowable as depending from an allowable base claim and for their own recited features which are neither disclosed nor suggested by the references of record either singly or in combination with one another.

Claim 12 recites a printing apparatus comprising [emphasis added]:

- a printer; and
- a printer monitor associated with printer and configured to monitor one or more usage profiles associated with the printer, the one or more usage profiles being independent of profiles associated with print job management or printer consumables management, *wherein at least one usage profile is defined in terms of one or more variables or parameters associated with I/O activities of data that is to be or has been printed on the printer.*

As discussed above, the Office's stated motivation for combining Ota and Evans in this rejection does not rise to the level of a motivation that supports a *prima facie* case of obviousness.

In view of the above discussion, the Office has not established a *prima facie* case of obviousness. Hence, for at least these reasons, this claim is allowable.

Claims 14-18 are allowable as depending from an allowable base claim and for their own recited features which are neither disclosed nor suggested by the references of record either singly or in combination with one another.

Claim 19 recites a printer management method comprising [emphasis added]:

- monitoring one or more variables or parameters associated with the security of a printer, *wherein at least one of the one or more variables or parameters is associated with I/O activities of data that is to be or has been printed on the printer*; and
- generating a notification if it appears likely that there has been a security breach.

As discussed above, the Office's stated motivation for combining Ota and Evans in this rejection does not rise to the level of a motivation that supports a *prima facie* case of obviousness. To this extent, Hines adds nothing of significance.

In view of the above discussion, the Office has not established a *prima facie* case of obviousness. Hence, for at least these reasons, this claim is allowable.

Claims 20 and 22-26 are allowable as depending from an allowable base claim and for their own recited features which are neither disclosed nor suggested by the references of record either singly or in combination with one another.

Claim 27 recites a printer management method comprising [emphasis added]:

- providing multiple printers in an organization;
- linking the printers together via an organization network;
- monitoring activities of the multiple printers;

- 5
- determining whether one or more printer activities meets one or more usage profiles associated with each of the printers, the usage profiles being associated with the security of each associated printer, *wherein at least one usage profile is defined in terms of one or more variables or parameters associated with I/O activities of data that is to be or has been printed on the printer*; and
 - taking a programmed action in the event that one or more printer activities meets one or more usage profiles for an associated printer.

10 As discussed above, the Office's stated motivation for combining Ota and Evans in this rejection does not rise to the level of a motivation that supports a *prima facie* case of obviousness. To this extent, Hines adds nothing of significance.

In view of the above discussion, the Office has not established a *prima facie* case of obviousness. Hence, for at least these reasons, this claim is allowable.

15

Claim 28 recites a printing system comprising [emphasis added]:

- 20
- multiple printers; and
 - one or more printer monitors associated with one or more of the multiple printers, the one or more printer monitors being configured to monitor one or more variables or parameters associated with the security of the one or more printers, *wherein at least one of the one or more variables or parameters is associated with I/O activities associated with data that has been or is to be printed on an associated printer*.
- 25

As discussed above, the Office's stated motivation for combining Ota and Evans in this rejection does not rise to the level of a motivation that supports a *prima facie* case of obviousness. To this extent, Hines adds nothing of significance.

30

In view of the above discussion, the Office has not established a *prima facie* case of obviousness. Hence, for at least these reasons, this claim is allowable.

Claims 29-31 and 33-35 are allowable as depending from an allowable base claim and for their own recited features which are neither disclosed nor suggested by the references of record either singly or in combination with one another.

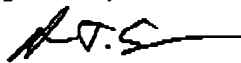
Conclusion

Applicant respectfully submits that the claims are in condition for allowance. Accordingly, Applicant respectfully requests that a Notice of Allowability be issued forthwith. If the next anticipated action is to be anything other than a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

15

Date: 8/9/05

Respectfully Submitted,


By: Allan T. Spawell et al (Reg. No. 38,519) for:
Lance R. Sadler
Reg. No. 38,605